

REMARKS

Claims 1-9 and 11-56 are presently pending. Claim 10 has been canceled. Claims 1-9 and 11-52 have been amended. Claims 53-56 have been withdrawn as being directed to nonelected species. Applicant reserves the right to prosecute claims 53-56 in one or more divisional applications.

Applicant respectfully requests reconsideration of the application in view of the foregoing amendments and the remarks appearing below.

Oath/Declaration

The Examiner has asserted that the present Declaration is defective because it fails to indicate the residence address of the sole inventor (Applicant).

Applicant respectfully disagrees. On page 1, line 5 of the Declaration (copy attached hereto for convenience), the Declaration explicitly states that "[m]y residence, post office address and citizenship are as stated below next to my name . . .". In accordance with standard Declaration format, this clause clearly refers to the inventor information on page 4 of the Declaration. Next to the inventor's name, "John E. Cronin", the Declaration sets forth the address of "130 Sunset Circle, Milton VT, USA", which is both the post office address and personal residence address of the inventor.

Applicant respectfully submits that it is clear from the Declaration that the address of "130 Sunset Circle, Milton VT, USA" is both a residence address and a post office address. This is so because the Declaration explicitly states this on page 1, line 5, as mentioned above.

In view of the foregoing, Applicant respectfully requests that the Examiner withdraw the objection to the Declaration.

Rejection under 35 U.S.C. § 112, First Paragraph

The Examiner has rejected claims 1-52 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In particular, the Examiner states that each of these claims includes the term "full range" and assert that the specification does not enable someone skilled in the art to practice the claimed invention because the specification fails to teach the meaning of "full range."

Applicant has amended each of independent claims 1, 8, 13, 22, 29, 35 and 44 so as to replace each occurrence of the term "full range" with the term "range," which Applicant asserts has a clear meaning in the context of the disclosure. This is so because the disclosure describes iterative methods for working through one or more ladders of abstraction relative to a particular invention for each of a plurality of pairs of life cycle aspects and invention types so as to obtain a range of patentable aspects, which connotes, among other things, a plurality of patentable aspects and/or a plurality of patentable aspects that vary in scope from narrower to broader.

Since the claims no longer contain the word "full" relative to "range," and because Applicant believes the term "range" has a clear meaning in the context of the present disclosure, Applicant believes that the present rejection is not proper. Consequently, Applicant respectfully requests that the Examiner withdraw the present rejection made under 35 U.S.C. § 112, first paragraph.

Rejections under 35 U.S.C. § 112, Second Paragraph

The Examiner has rejected claims 1-52 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention.

In particular, the Examiner asserts that the terms "full range" and "full range of patentable aspects" are not defined, thereby rendering the claims indefinite.

Regarding the term "full range," Applicant has amended each of independent claims 1, 8, 13, 22, 29, 35 and 44 to remove the word "full," leaving only "range," which, as discussed above relative to the 35 U.S.C. § 112, first paragraph, rejection, Applicant believes has a clear meaning in the context of the present disclosure.

Regarding the phrase "full range of patentable aspects," the "full range" portion is as just discussed. The "patentable aspects" portion is discussed immediately below.

The Examiner also asserts relative to the phrase "full range of patentable aspects" that it is unclear how the steps of the invention ensure patentability. Applicant agrees with the Examiner that nothing in the present invention guarantees that the aspects obtained using a method of the present invention are patentable because, e.g., the present invention, as claimed, does not address issues relating to patentability, such as novelty, nonobviousness, enablement, written description, examination, etc.

In this connection, Applicant has amended each of claims 1, 8, 13, 22, 29, 35 and 44 to change the term "patentable aspects" to "patent eligible aspects." Applicant believes that the term "patent eligible aspects" more precisely defines the results obtained by implementing the present invention. That is, the aspects derived by performing the various steps of the present invention result in subject matter that is eligible for patent protection, i.e., is statutory subject matter, but that is not necessarily guaranteed to be patentable, which as the Examiner appears to be pointing out, depends on many factors not explicitly addressed by the present invention.

In addition, the Examiner asserts that the terms "broad aspects" and "narrow aspects" have not been defined and that it is unclear how "why" questions lead to broad aspects and "how" questions lead to narrow aspects. First, Applicant notes that the claims have been amended so that only dependent claims 4, 24, 37 and 46 include "broad" and "narrow" aspects and "why" and why "how" questions. However, Applicant respectfully disagrees with the Examiner that "broad" and "narrow" aspects are not defined and that it is not clear how "why" questions lead to broader aspects and why "how" questions lead to narrower aspects.

Applicant believes that meanings of "broad aspects" and "narrow aspects" and the concepts of "why" questions leading to broad aspects and "how" questions leading to narrow aspects are clear to someone skilled in the art of applying creativity tools. All of these items relate to the creativity tool known in the art as a "ladder of abstraction," which is described in detail in the present specification at page 12, line 1 to page 14, line 8. As is well-known to skilled artisans, and as described in the specification, asking a "why" question results in movement up a ladder of abstraction, in other words, to concepts more abstract, i.e., broader, than the concept relative to which the question was asked. On the other hand, asking a "how" question clearly results in movement down the ladder of abstraction, in other words, to concepts less abstract than the concept relative to which the question is asked. Applicant refers the Examiner to the example provided in the specification at page 12, line 1 to page 14, line 8 for a dry-erase marker, wherein "why" questions lead to broad aspects, e.g., other ways of enhancing the performance of a marker relative to the fluid level window, and "how" questions lead to narrow aspects, e.g., particular processes that can be used to make a marker having a fluid level window.

Applicant notes that the law does not require that claim terminology be construed relative to just any "plain" meaning, but rather the "ordinary and customary meaning given to the term

by those of ordinary skill in the art.” See, e.g., MPEP § 2111.01 (emphasis added). When terminology is used in this manner, i.e., consistently relative to the ordinary and customary meaning in the art, as in the present application, an applicant, *a fortiori*, does not need to explicitly define terminology for the simple reason that the applicant has not redefined the terminology.

In this connection, the Examiner has not cited the ordinary and customary meanings in the art of any of the terminology at issue. Rather, the Examiner has merely stated that the terms “broad aspects” and “narrow aspects” have not been defined. However, Applicant respectfully asserts that it is not an applicant’s burden to show that claim terminology is used in a manner consistent with the ordinary and customary meaning in the art and, therefore, does not require explicit definition in the specification. Rather, Applicant believes that it is the Examiner’s burden to show that an applicant has not used terminology in a manner consistent with relevant art.

The Examiner further asserts that it is unclear what the relationship of the elements of the steps is. In particular, the Examiner asks how the step of modifying the first aspect of the invention while holding the invention type and life cycle constant identifies a range of patentable aspects. Applicant has amended the claims so that this question is moot.

The Examiner also rejects claims 1-52 under 35 U.S.C. § 112, second paragraph, because the Examiner would have to employ too much speculation to reject the claims in view of the prior art. Applicant has amended the claims and, having done so, believes that this rejection is moot.

For at least the foregoing reasons, Applicant respectfully requests that the Examiner withdraw the present rejections made under 35 U.S.C. § 112, second paragraph.

Rejection under 35. U.S.C. § 101

The Examiner has rejected claims 1-52 under 35 U.S.C. § 101 as being directed to nonstatutory subject matter. In particular, the Examiner states that the invention as claimed is not within the technological arts and does not produce a concrete result because it does not produce a reproducible result. Applicant respectfully disagrees.

To support the assertion that the claimed invention is not in the technological arts, the Examiner argues that the recited steps do “not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of pencil and

paper.” This quotation may have applied to very old law but certainly does not properly characterize present case law on the subject. Indeed, as well-stated in the U.S. Patent and Trademark Office’s (USPTO’s) own training materials on the subject, a “method or process remain statutory even if some or all of the steps therein can be carried out: [1)] in the human mind[;] [2)] with the aid of the human mind[;] or [3)] because it may be necessary for one performing the method or process to think.” “35 U.S.C. 101 Training Materials,” U.S. Patent and Trademark Office, V. Millin et al., www.uspto.gov/web/menu/pbmethod/trangmaterials.ppt, slide 17 (citation omitted) (emphasis added) (excerpts attached hereto for convenience). “The key is that a useful, concrete and tangible result must be produced.” *Id.*

Despite the fact that the focus of the inquiry into whether or not an invention is statutory subject matter is whether the claimed invention produces a useful, concrete and tangible result, Applicant respectfully asserts that the present claims, as amended, are within the technological, or useful, arts. Indeed, because the term “technological arts” is so broad, the courts have essentially been forced to construe it by providing examples of what it is not. For example, the courts have indicated that “technological arts” does not include liberal arts, nor social sciences. These sorts of constraints on “technological arts” leave much room for what this term in fact covers.

In the present case, it could hardly be asserted that the art of inventing inventions in which the present claims fall is not part of the “technological arts.” This would be an absurd proposition, since inventions themselves, by definition, are in the technological arts. As a test, it is clearly seen that the art of inventing inventions is not a social science, nor is it a liberal art. Consequently, Applicant respectfully asserts that the present invention comfortably falls within the technological arts.

In rejecting the claims the Examiner further asserts that there is no recitation of technology in the claims. This statement, too, does not correctly characterize the present state of the relevant law. As discussed above, claims can be statutory even if the steps are carried out entirely within a human mind. Such claims do not require any positive recitation of technology. Again, the crux of the statutory subject matter test is whether or not the claimed invention produces a useful, concrete and tangible result.

As an example of a claim issued by the USPTO that meets the standard identified in the above-mentioned Training Materials, but apparently would not pass muster under the test set forth by the Examiner, following is claim 1 of U.S. Patent No. 5,190,458 to Driesener:

1. A method of psychological testing of a person, comprising:
 - (a) instructing the person to produce a drawing which includes at least one pictorial representation of each of at least a majority of the following items: a hand, an eye, a tree, a fish, a star, a spiral, a half-circle, and a zig-zag; and
 - (b) subjecting to psychological interpretation the drawing produced in response to step (a).

Clearly, there is no positive recitation of "technology" in this claim. However, the subject matter of this claim produces a useful, concrete and tangible result, i.e., a psychological evaluation of a person. In this connection, it is noted that usefulness need not be expressly recited in the claims, but rather it may be inferred. *See, e.g.*, USPTO Training Materials, at slide 19. The USPTO's database contains many more examples of issued claims that do not expressly recite "technology," in contradiction to the Examiner asserted requirement for patentability.

Regarding the Examiner's assertion that the present claimed invention does not produce a concrete result because it does not produce a reproducible result, Applicant asserts that the result of each amended claim 1-52, i.e., a list of at least some of the range of patent eligible aspects of the invention, is indeed concrete, i.e., the result (list) is assured, at least as far as each different invention to which a method of the present invention is applied allows. While it is true that the content of the result (i.e., list) may vary depending upon the questions asked, the participants involved and the invention acted upon, among other things, this sort of variability does not go to the concreteness of the result.

If this were the case, then a claim such as claim 1 of the Driesener patent appearing above would not be patentable because the psychological interpretation varies from patient to patient and from evaluator to evaluator. However, this is not the case, because the question of concreteness goes to the result achieved, not the content of the result. In the Driesener example, the result is that a psychological evaluation occurs, rather than interpreted details of the evaluation. In the present case, the result is the generating of a list of at least some of the patent eligible aspects in the range of such aspect, not the aspects in and of themselves.

In connection with the rejection based on lack of concreteness, the Examiner also asserts that the lack of definition of the phrase "full range of patentable aspects" contributes to the

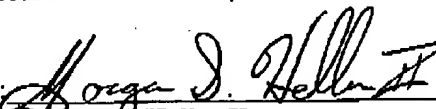
claims not providing concrete results. Applicant asserts that this assertion is moot, since this phrase no longer appears in any of the amended claims.

For at least the foregoing reasons, Applicant believes that the amended claims are indeed statutory under 35 U.S.C. § 101. Therefore, Applicant respectfully requests that the Examiner withdraw the present rejection.

Conclusion

In view of the foregoing, Applicant respectfully submits that claims 1-52, as amended, are in condition for allowance. Therefore, prompt issuance of a Notice of Allowance is respectfully solicited. If any issues remain, the Examiner is encouraged to call the undersigned attorney at the number listed below.

Respectfully submitted,
IPCAPITAL GROUP, INC.

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Attachments

Declaration

Excerpts from USPTO Training Materials

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